REMARKS/ARGUMENTS

With entry of this Amendment, claims 19, 20, 32-45 and 57-61 are pending; claims 19, 20, 35-45 and 57-59 have been amended; and claims 21-31 and 46-59 have been cancelled without prejudice to further prosecution in a related case. Claim 19 has been amended to more particularly set forth the claimed method and, in particular, to incorporate the limitations of claim 20 into claim 19. As amended, claim 19 is directed to a method for diagnosing a disease in a subject by detecting a plurality of diagnostic markers of the disease. Claim 20 and claims 35-43 have been amended to refer to "a plurality of adsorbents" and "at least one adsorbent" as appropriate. Claims 43-45 have been amended to clarify the embodiments wherein an antibody or a plurality of antibodies is used as the adsorbent. Finally, claims 57-59 have been amended to correct their dependencies so that they are now properly dependent on claims 19, 20 and 32-45. Support for the amendments to the claims can be found throughout the specification and claims as originally filed and, thus, no new matter has been introduced.

Applicants thank Examiner Chin for the telephonic interview held on June 14, 2004. During the interview, a number of issues were discussed that have helped Applicants more fully address the concerns of the Examiner. Applicants thank Examiner Chin for his time.

In the Office Action, claims 19-34, 39, 42-47, 52 and 55-61 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. Claims 19, 20, 28-30, 33, 34, 42, 43, 46, 46 and 55-61 were rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Hutchens *et al.* (U.S. Patent No. 5,719,060). Claims 31, 32, 44 and 45 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Hutchens *et al.* Finally, claims 21-27 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Hutchens *et al.* in view of Foster *et al.* (U.S. Patent No. 4,444,879). Each of these rejections is addressed in turn below in the order set forth by the Examiner.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 19-34, 39, 42-47, 52 and 55-61 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. In making this rejection, the Examiner has indicated

that the recitation of "resolves" in claim 19 is unclear. During the telephonic interview, the Examiner indicated that this rejection could be overcome by amending claim 19 to replace "resolves" with "binds."

In order to expedite prosecution, claim 19 has been amended to replace the term "resolves" with the term "binds" as suggested by the Examiner. As amended, step a) of claim 19 now recites:

> a) contacting at least one adsorbent that is attached to a substrate with a biological sample from the subject to allow the at least one adsorbent to bind the diagnostic markers;

In view of the amendment to claim 19, the Examiner's concern is overcome. Accordingly, Applicants urge the Examiner to withdraw this rejection.

Rejection Under 35 U.S.C. § 102(e)

Claims 19, 20, 28-30, 33, 34, 42, 43, 46, 47 and 55-61 were rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Hutchens *et al.* (U.S. Patent No. 5,719,060) ("Hutchens *et al.*"). To the extent this rejection is applicable to the newly amended claims, Applicants respectfully traverse this rejection for the reasons set forth below.

Anticipation of a claim is only established where "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" (*Verdegal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). Applicants respectfully submit that Hutchens *et al.* did not teach "a method for diagnosing a disease in a subject by detecting a plurality of diagnostic markers of the disease." In fact, there is no disclosure in Hutchens *et al.* that a disease can be diagnosed by detecting the plurality of diagnostic markers. As discussed with Examiner Chin during the telephonic interview, Hutchens *et al.* disclosed that the arrays of affinity devices can selectively adsorb a plurality of different analytes (*see*, column 19, lines 40-45 of Hutchens *et al.*); however, Hutchens *et al.* did not teach or suggest a method for diagnosing a disease in a subject by detecting a plurality of diagnostic markers of the disease in a sample from the subject. Since this express element is absent in the Hutchens *et al.* patent, the Hutchens *et al.* patent did ***not***

anticipate the present claims. Thus, any rejection of claims under 35 U.S.C. § 102 over Hutchens *et al.* is improper. Accordingly, Applicants urge the Examiner to withdraw this rejection.

First Rejection Under 35 U.S.C. § 103(a)

Claims 31, 32, 44 and 45 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Hutchens *et al.* Applicants respectfully traverse. The claims as amended are directed to methods of diagnosing a disease comprising detecting a plurality of diagnostic markers for the disease. Hutchens *et al.* did not teach or suggest the use of a plurality of diagnostic markers in the diagnosis of a disease. Therefore, the claimed method would not have been obvious over Hutchens *et al.*

Second Rejection Under 35 U.S.C. § 103(a)

Claims 21-27 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Hutchens *et al.* in view of Foster *et al.* (U.S. Patent No. 4,444,879).

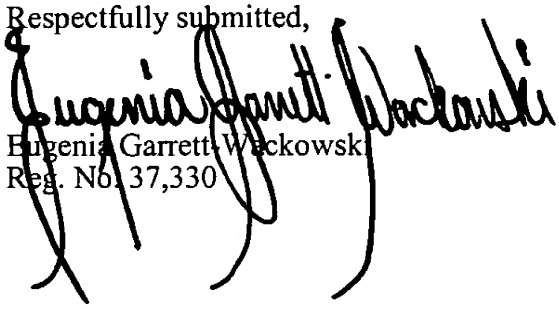
In order to expedite prosecution, claims 21-27 have been cancelled without prejudice to further prosecution in a related patent application. In view of the cancellation of claims 21-27, the Examiner's rejection is rendered moot. Accordingly, Applicants urge the Examiner to withdraw the rejection under 35 U.S.C. § 103(a).

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,



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